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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,813	05/28/2002	Nigel Jeffrie Ricketts	RR-491 PCT/US	3822

7590

07/02/2003

Rodman & Rodman
7 South Broadway
White Plains, NY 10601

EXAMINER

ANDREWS, MELVYN J

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 07/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,813

Applicant(s)

RICKETTS ET AL.

Examiner

Melvyn J. Andrews

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 14-16 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

Applicant's election with traverse of Claims 1-12 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that set forth in Paper No.10. This is not found persuasive because the special technical features linking the three groups as set forth in Claim 1 does not provide a contribution over the prior art Dougherty et al (US 5,115,868) and no single inventive concept exists as set forth in Paper No.9.

Applicants' arguments are not convincing that Claim 1 is patentable over Dougherty et al this is supported by International Preliminary Examination Report dated September 5, 2001 page 4/4

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT publication WO 96/22129. The PCT publication discloses compounds

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suitable for processes for controlling or extinguishing fires (Page 7, lines 21 to last line, page 12, lines 21-23 and page 14, lines 2-7) it would have been obvious to one of ordinary skill in the art to select a compound with a low GWP since GWP is a result effective variable *In re Boesch*, 205 USPQ 215.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty Jr et al (US 5,115, 868). Dougherty Jr et al discloses compositions for extinguishing, preventing or controlling fires (col.2, line 65 to col.3, line 33, col.4, line 31 to 38 and Examples 1 and 5) which include difluoromethane (HFC-32), heptafluoropropane (HFC-227), 1,1,1,2 tetrafluoroethane (HFC-134a) and Dougherty Jr et al discloses that GWP is a result effective variable (Example 4) it would have been obvious to one of ordinary skill in the art to select a compound with a low GWP since the GWP is a result effective variable *In re Boesch*, 205 USPQ 215.

Claims 1-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT publication WO 91/02564. The PCT publication discloses fluorinated hydrofluorocarbons such as pentafluoroethane (page 4, lines 1-20) it would have been obvious to one of ordinary skill in the art to select a compound with a low GWP since GWP is a result effective variable *In re Boesch*, 205 USPQ 215.

Claims 1-12 rejected under 35 U.S.C. 103(a) as being unpatentable over PCT publication WO 96/22129, Dougherty Jr et al (US 5,115, 868) and PCT publication WO 91/02564 as applied to claim 1 above, and further in view of Ricketts et al (US 6,167,944). The PCT publications and the patent to Dougherty et al do not explicitly disclose a cover gas for molten magnesium but Ricketts et al discloses a casting

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magnesium ingots using protective cover gas using dilute SF₆ / dry air gas mixture but not the claimed fluoride inhibiting agents with low GWP but these are disclosed by the '129 publication, Dougherty Jr et al and the '944 publication, it would have been obvious to one of ordinary skill in the art to select a compound with a low GWP since GWP is a result effective variable *In re Boesch*, 205 USPQ 215.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvyn J. Andrews whose telephone number is 703-308-3739. The examiner can normally be reached on 8:00A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


MELVYN ANDREWS
PRIMARY EXAMINER

mja
June 30, 2003